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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,512	11/26/2003	Sumitake Kobayashi	1734.1001CIP	6099
21171 7590 01/15/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER BIAGINI, CHRISTOPHER D	
			ART UNIT 2142	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/721,512

**Applicant(s)**

KOBAYASHI ET AL.

**Examiner**

Christopher D. Biagini

**Art Unit**

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/17/2007.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Comments Regarding Examination***

This application has been assigned to a new Examiner. Contact information may be found at the end of this Action.

### ***Response to Arguments***

Applicant's arguments regarding the Information Disclosure Statement have been considered and are persuasive. The cited reference has been considered.

Applicant's arguments regarding the drawings have been considered and are persuasive. Accordingly, the objection is withdrawn.

Applicant's arguments regarding the rejection of claims 14-20, 23, and 24 under 35 USC 101 have been fully considered but are not persuasive. Although the term "machine" generally implies hardware, Applicant's arguments expressly indicate that a "computer server" may consist entirely of software: "functions or operations performed by the claimed 'computer server' as a machine may be implemented in software and/or computing hardware" (emphasis added). Software *per se*, in the absence of a structurally and functionally interrelated computer-readable medium, is not statutory subject matter. See also page 14, lines 13-18 of the instant specification.

Applicant's arguments regarding the prior art rejections of claims have been considered and are persuasive. However, regarding the argument that "Yoshida's jobs are not assigned to a multifunction machine but merely perform a job," the Examiner respectfully disagrees. Jobs are requested by, and assigned to, various multifunction machines on a network (see Yoshida, col. 4,

lines 30-51 and col. 10, lines 19-22). Upon further consideration, a new grounds of rejection is made.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-20, 23, and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. When read in light of the specification, the claims may be reasonably interpreted as consisting entirely of software. Software *per se*, in the absence of a structurally and functionally interrelated computer-readable medium, is not statutory subject matter.

***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Specifically, the specification does not disclose that "a completion-of assignment notification [assigns] the request processor" or that a separate "command pertaining to the function request" is used to determine whether to cancel assignments. Furthermore, the terms "operation manager" and "request processor" are not present in the specification.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The invention as claimed appears to require that the "completion-of-assignment notification" assign the request processor to the multifunction machine. However, in the specification, this task is performed by an "assigning unit."

The invention as claimed appears to require that the computer server receive two separate messages from the multifunction machine: a "function request" and a "command pertaining to the function request." In the specification, only the "function request" is received. Indeed, in the claims as originally filed, the "assignment cancelling means" uses the function request itself, not a "command pertaining to the function request," to determine whether to cancel the assignment.

The invention as claimed requires an "operation manager" and a plurality of "request processors," but these terms do not appear in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Specific examples are given below.

Regarding claim 14, the limitation "a plurality of request processors each upon the activating by the operation manager..." is unclear. It is unclear whether *all* of the request processors "communicate with any of the plurality of functions" when the operation manager activates *one* request processor, or if only the activated request processor communicates.

The claim recites the limitation "the multifunction machine" on lines 5, 8-9, 10, 11, and 15, but a plurality of multifunction machines was introduced on lines 1 and 4. It is unclear to which multifunction machine this limitation is intended to refer.

The claim recites the limitation "the request processor" on lines 15 and 17, but a plurality of request processors was introduced on line 7. It is unclear to which request processor this limitation is intended to refer.

The claim recites the limitation "...sends a completion-of-assignment notification assigning the request processor to the multifunction machine" on lines 14-15. It is unclear how a notification can perform an assignment. A notification, as commonly used in the art, is merely a message, an inert arrangement of data that is incapable of performing a task.

The claim recites the limitation “the assigned multifunction machine” on line 19.

However, the claim does not previously assign a multifunction machine. Processors are assigned to multifunction machines, but not vice versa.

Claims 21, 22, and 24 have deficiencies similar to those of claim 14 and are rejected for the same reasons as given above.

Any claim not specifically addressed above is rejected at least for incorporating the deficiencies of a parent claim upon which it depends.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-17 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (US Patent No. 6,130,757) in view of Kimura (US Patent No. 6,226,097).

Regarding claim 14, note that the preamble has been given patentable weight as it is relied upon by the body of the claim (see “the multifunction machines” on lines 4-5).

Yoshida shows a computer server (copy machine 1) connected with a plurality of multifunction machines (copy machines 4 and 6) via a network (see Fig. 1), the computer server comprising:

- a plurality of functions that perform processing to a document (comprising sorting, stapling, faxing, printing, image editing, etc.: see col. 8, lines 61-67 and col. 10, lines 14-23);
- an operation manager (CPU 103) receiving a function request from at least one of the multifunction machines and activating a request processor (comprising a job: see col. 10, lines 1-6) communicating with the multifunction machine based upon the function request (see col. 10, lines 60-65); and
- a plurality of request processors (comprising jobs) each upon the activating by the operation manager communicate with any of the plurality of functions and the multi-function machine (comprising sending results to the multi-function machine: see col. 10, lines 60-63), and cause one of the plurality of functions to perform a processing to document data received from the multi-function machine according to the function request from the multifunction machine (comprising completing the requested process: see col. 10, lines 60-63),
- wherein the activated request processor sends a completion-of-assignment notification assigning the request processor to the multifunction machine and indicating that processing of the function request is possible (comprising sending a format message, which confirms the job request and indicates that the request is possible provided the client supplies the correct format: see col. 9, lines 40-43).



Yoshida does not specifically show wherein the activated request processor cancels the assignment of the processor to the multifunction machine, when a command pertaining to the function request is not received from the assigned multifunction machine within a predetermined amount of time.

Kimura shows canceling the assignment of a processor (deleting a pending print job and breaking a connection with a requesting client) when a command pertaining to a function request (print data) is not received from a machine (client PC) within a predetermined amount of time (see col. 11, lines 17-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Yoshida with the cancellation process of Kimura in order to minimize delays in the print queue caused by unresponsive clients (see Kimura, col. 11, lines 47-48).

Regarding claim 15, the combination of Yoshida and Kimura shows the limitations of claim 14 as applied above, and Yoshida further shows wherein the completion of-assignment notification has information of the function (comprising the required format: see col. 9, lines 40-43) and the function is processable by the server (see col. 10, lines 60-63).

Regarding claim 16, the combination of Yoshida and Kimura shows the limitations of claim 14 as applied above, and Yoshida further shows wherein the function is a fax that faxes image data (see col. 10, lines 56-60), and wherein the request processor controls the fax and sends the image data received from the multifunction machine, when the request processor

receives from the multifunction machine a fax command as the function command to fax the image data (see col. 4, lines 46-52).

Regarding claim 17, the combination of Yoshida and Kimura shows the limitations of claim 14 as applied above, and Yoshida further shows wherein the function is a recorder that records image data (note that the server must record image data in order to perform operations on it), and wherein the request processor records the image data received from the multifunction machine on the recorder, when the request processor receives from the multifunction machine a record command (comprising the requests which result in image data being stored, even if only temporarily) as the function command to record the image data (see col. 10, lines 60-63).

Claims 21 and 22 have limitations similar to those of claim 14 and are rejected for the same reasons as applied above.

Regarding claim 23, the combination of Yoshida and Kimura shows the limitations of claim 14 as applied above, and Yoshida further shows wherein the server has information of each of the multifunction machines, and the information has a type of executable job (see col. 10, lines 8-11).

Regarding claim 24, note that the preamble has been given patentable weight as it is relied upon by the body of the claim (see "the multifunction machines" on lines 4-5).

Yoshida shows a server (copy machine 1) connected with a plurality of multifunction machines (copy machines 4 and 6) via a network (see Fig. 1), the computer server comprising:

- a plurality of functions that perform processing to a document (comprising sorting, stapling, faxing, printing, image editing, etc.: see col. 8, lines 61-67 and col. 10, lines 14-23);
- an operation manager (CPU 103) receiving a function request from at least one of the multifunction machines and activating a request processor (comprising a job: see col. 10, lines 1-6) communicating with the multifunction machine based upon the function request (see col. 10, lines 60-65); and
- a plurality of request processors (comprising jobs) each upon the activating by the operation manager communicate with any of the plurality of functions and the multi-function machine (comprising sending results to the multi-function machine: see col. 10, lines 60-63), and cause one of the plurality of functions to perform a processing to document data received from the multi-function machine according to the function request from the multifunction machine (comprising completing the requested process: see col. 10, lines 60-63),
- wherein the activated request processor sends a completion-of-assignment notification assigning the request processor to the multifunction machine and indicating that processing of the function request is possible (comprising sending a format message, which confirms the job request and indicates that the request is possible provided the client supplies the correct format: see col. 9, lines 40-43).

- wherein the server has option information, the option information is information of any of the plurality of functions executable by the server (comprising a list of functions published by the server: see col. 9, lines 28-33).

Yoshida does not specifically show wherein the activated request processor cancels the assignment of the processor to the multifunction machine, when a command pertaining to the function request is not received from the assigned multifunction machine within a predetermined amount of time.

Kimura shows canceling the assignment of a processor (deleting a pending print job and breaking a connection with a requesting client) when a command pertaining to a function request (print data) is not received from a machine (client PC) within a predetermined amount of time (see col. 11, lines 17-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Yoshida with the cancellation process of Kimura in order to minimize delays in the print queue caused by unresponsive clients (see Kimura, col. 11, lines 47-48).

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (US Patent No. 6,130,757) in view of Kimura (US Patent No. 6,226,097), and further in view of Barrett (US Patent No. 5,323,393).

Regarding claim 18, the combination of Yoshida and Kimura shows the limitations of claim 14 as applied above, but does not show a utilizing situation recorder that records utilizing

situation information received from the plurality of multifunction machines, the utilizing situation information being information how often each of the multifunction machines is used; and a utilizing situation information transmitter that transmits, when any one of the nodes on the network makes a request for transmitting the utilizing situation information, the utilizing situation information back to said node having transmitted a transmission request.

Barret shows a utilizing situation recorder (comprising an NEB) receiving information on how often a machine is used (see col. 47, lines 50-56 and col. 48, lines 3-16), a utilizing situation transmitter (comprising an NEB) that transmits the information to a requesting machine (see col. 6, lines 38-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Yoshida and Kimura with the recorder and transmitter taught by Barrett in order to provide administrative personnel with usage information.

Regarding claim 19, the combination of Yoshida, Kimura, and Barrett shows the limitations of claim 18 as applied above, but does not explicitly show wherein the utilizing situation information transmitter transmits the utilizing situation information to the network nodes in accordance with a predetermined schedule.

However, the Examiner takes official notice that it is notoriously old and well-known in the art to transmit information according to a predetermined schedule. It would have been obvious to one of ordinary skill in the art to modify the system of Yoshida, Kimura, and Barrett to transmit the information according to a predetermined schedule in order to ensure that an updated copy is always available for an administrator to review.

Regarding claim 20, the combination of Yoshida, Kimura, and Barrett shows the limitations of claim 18 as applied above, but does not explicitly show a destruction detecting unit that detects a destruction of the information recorded on the utilizing situation recorder; and a utilizing situation information managing unit that requests each of the multifunction machines to transmit the utilizing situation information when the destruction detecting unit detects the destruction, and again records the transmitted utilizing situation information on the utilizing situation recorder.

However, the Examiner takes official notice that it is notoriously old and well-known in the art to detect missing information and request that it be resent. It would have been obvious to one of ordinary skill in the art to modify the system of Yoshida, Kimura, and Barrett to provide for the restoration of destroyed data in order to ensure that a valid copy is always available for an administrator to review.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Biagini whose telephone number is (571) 272-9743. The examiner can normally be reached on weekdays from 8:30 AM to 5:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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